



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,991	12/14/2005	Fraser Harvie	PT-2655-US-PCT	9555
68622	7590	03/04/2010	EXAMINER	
NORMAN F. HAINER, JR. SMITH & NEPHEW, INC. 150 MINUTEMAN ROAD ANDOVER, MA 01801			LEWIS, RALPH A	
			ART UNIT	PAPER NUMBER
			3732	
			MAIL DATE	DELIVERY MODE
			03/04/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,991	<b>Applicant(s)</b> HARVIE ET AL.	
	<b>Examiner</b> Ralph A. Lewis	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29,50,62-69,72-75,78-80 and 82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29,50,62-69,72-75,78-80 and 82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **Rejections based on Prior Art**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29, 50, 67, 72-75, 78-80 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvie et al (US 6,620,185) in view of Harwin et al (US 5,618,314).

Initially, it is noted that the present application does not claim priority back to the 09/604,387 application (6,620,185 patent) and that the earlier patent (Harvie et al) has a different inventive entity from the present application.

Harvie et al disclose a handpiece 52 having a cannulated tube 71 mounted on the handpiece 52 and having a tip through which a suture 70 is received, carried, and dispensed. The Harvie et al cannulated tube 71 includes a heating device 188 disposed therein. In regard to the "suture carrying device" limitation, Harvie et al indicates that the suture 70 may include a rigid shaped member 410 (Figure 21F) for increasing the resistance to the suture from being pulled out of the bone. The Harvie et al suture carrying device 410 does not include the claimed eyelet, pair of channels or the cannula tip portion with flat areas for restricting rotation of the suture carrying device. Harwin et al, however, teach a similar suture anchoring device having an eyelet 30 for receiving a

Art Unit: 3732

suture and a pair of channels 50 for engaging a flattened keying area 280 (Figure 8B) of the cannulated tube insertion tool so that the suture carrying device can be easily manipulated and controlled. To have formed the Harvie et al suture carrying member 410 (Figure 21F) with an eyelet and channels that cooperate with the Harvie et al cannulated tube so that the suture carrying device may be more accurately manipulated and controlled would have been obvious to one of ordinary skill in the art in view of the teaching by Harwin et al.

In regard to claim 67, note tube 186 which inherently has some insulating properties.

Claims 64 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvie et al (US 6,620,185) and Harwin et al (US 5,618,314) in view of Doi et al (US 3,584,198).

Harvie et al fail to disclose the structure of heating element 188. Merely selecting a conventional off the shelf flexible foil heating element as that disclosed by Doi for the heating element 188 of Harvie et al would have been obvious to one of ordinary skill in the art as a matter of routine practice in carrying out the Harvie et al invention.

Claims 65, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvie et al (US 6,620,185) and Harwin et al (US 5,618,314) in view of Lavenuta (US 6,660,554).

Harvie et al fail to disclose the operation and control of heating element 188. The use of thermistors for controlling the heat output from such heaters is conventional to prevent over heating, note Lavenuta column 1, lines 22-35. Merely selecting conventional off the shelf thermistors as that disclosed by Lavenuta for controlling the heating element 188 of Harvie et al in order to prevent overheating would have been obvious to one of ordinary skill in the art as a matter of routine practice in carrying out the Harvie et al invention.

### **Applicant's Remarks**

In response to the rejection based on Harvie et al and Harwin et al applicant argues that suture carrying device 5 of Harwin et al fails to include "a pair of channels extending from the eyelet" as is required in independent claim 29. The examiner indicated that in Harwin et al the structure 30 met the eyelet limitation and channels 50 met the channels limitation. The examiner notes that the "eyelet" terminology is reasonably interpreted as more than simply the opening 30, but also the surrounding structure in which the opening is formed. More particularly, there can't be an opening or an eyelet unless there is also a boundary surrounding structure. The examiner is further of the position that the channels 50 that are immediately adjacent the opening 30 reasonably meet the limitation that they extend from the boundary structure that forms the eyelet. Applicant is interpreting the claims much more narrowly than the language reasonably suggests. The examiner suggests more clearly and distinctly claiming the feature.

**Action Made Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3732

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis  
March 1, 2010

/Ralph A. Lewis/  
Primary Examiner, Art Unit 3732